

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. ZOECKLER

Appeal 2007-0809
Application 09/559,704
Technology Center 3700

MAILED

JUN - 1 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Oral Hearing Held: May 15, 2007

Before MURRIEL CRAWFORD, JENNIFER BAHR, and LINDA HORNER Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

IAN A. CALVERT, ESQUIRE
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ALSO PRESENT:

KEATS GRINALTY, ESQUIRE
BARRY BIDDLE, ESQUIRE

1 The above-entitled matter came on to be heard on May 15, 2007,
2 commencing at approximately 1:02 p.m., at the United States Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victoria
4 L. Wilson, Notary Public.

5

6 THE USHER: Good afternoon. Calendar Number 28, Appeal
7 Number 2007-0809. Mr. Calvert.

8 MR. CALVERT: Good afternoon, your Honors.

9 JUDGE CRAWFORD: Good afternoon.

10 JUDGE CRAWFORD: Good afternoon.

11 MR. CALVERT: Good afternoon.

12 JUDGE CRAWFORD: Could you introduce your guests.

13 MR. CALVERT: Yes, ma'am. Mr. Keats Grinality, with our office in
14 Atlanta, and Mr. Barry Biddle, who is an attorney with the assignee, Graphic
15 Packaging International.

16 Now, this case involves making cartons and carton blanks, and there
17 are -- basically, you can make cartons out of corrugated material or non-
18 corrugated material, and here we are concerned with making them out of
19 non-corrugated material.

20 Non-corrugated is preferred because, you know, corrugated material,
21 it is more expensive, it is bulkier and so forth, and one thing, especially,
22 also, it is hard to print high-quality graphics right onto corrugated material,
23 whereas you can print them onto the non-corrugated; that's not a problem.

24 Now, the examiner -- well, first of all, let me get to the invention here.
25 We take a web of paperboard, which has come off of a roll, but the problem
26 is, of course, with paperboard, it is not as strong as corrugated material, so

1 you need to reinforce some of these carton blanks at appropriate points so
2 that they will be strong enough to do the job they are intended to do.

3 So what is involved here, we take ribbons of material and laminate
4 them onto the web at appropriate points.

5 This material -- one advantage of the invention is this material can be
6 paperboard which otherwise would go to waste. You get a big roll of
7 paperboard from the mill and then you have to cut it down to the width of
8 the particular web you want to make it from -- make the carton blanks from,
9 and the excess may be just thrown away; it is called trim.

10 You may just throw it away, but in this case you can use it to reinforce
11 the appropriate areas of the web as it is coming out of the -- coming into the
12 process where they cut the carton blanks out of the web.

13 And what we are concerned here with, as you will see from the claims
14 on appeal, is with attaching -- attaching this ribbon of material, basically, to
15 substantially all of a panel portion.

16 We have two independent claims, claim 1 and claim 25, which are
17 both pretty much the same. One is making carton blanks and the other is
18 making cartons, but the relevant limitations are the same in both claims.

19 The problem has come here with this term "panel portions." The
20 examiner says, Well, a panel portion is a portion of a panel. And as you will
21 see from the claim, a panel portion is not a portion of a panel. A panel
22 portion is a portion of the web that will become a panel separated by fold
23 lines.

24 As step A in claim 1 says, you advance the web and it has
25 longitudinally extending panel portions that will become panels separated by
26 fold lines in completed paperboard cartons. So what we are doing here is --

1 and then what we want to do is apply, adhere, a ribbon of reinforcing
2 material, and step B says to overlie and adhere to substantially all of a
3 selected panel portion of the web.

4 So basically, what this is drawn to is, if you look at, say, figure 8 of
5 the application, we have -- it is a carton and you can see that there are
6 ribbons, 123, that are adhered to the panels, 124, and they cover
7 substantially all of those panel portions. And they -- those panel portions
8 extend between the fold lines, 125 at the top and 125 at the bottom.

9 In this particular case, this is, like, for a drink carton where it has, say,
10 cartons of orange juice or something like that, and if you would want to
11 stack these cartons up, they are not strong enough to support the weight of
12 the cartons up above unless you reinforce the side walls of the carton.

13 Now, the examiner, first of all, rejects these claims, the independent
14 claims, as anticipated by Stone under section 102, and as I say, the examiner
15 says, Because -- I think because of the examiner's interpretation of panel
16 portions as meaning a portion of a panel and not a portion of the web that's
17 going to become a panel.

18 So what Stone has is a -- he is making a carton which is going to have
19 a sort of a flip top on it, and if you look at figure -- figure 1 of Stone, you
20 can see there is a tear strip. You tear around the top of the carton and then
21 you can flip up the lid.

22 Now, inside the carton, there is this collar 24, and the collar 24 is
23 adhered to the inside of the carton, but as you can see, you can only adhere it
24 to the part of the carton that's below this tear strip. If you adhered it to the
25 carton that's above the tear strip, then you couldn't open the top of the box.

26 So I have a little -- may I approach the bench?

1 JUDGE CRAWFORD: Yes.

2 MR. CALVERT: I have a visual aid here you might like to look at.

3 This is just a copy of figures 2 and 3 of the Stone reference and -- now, this
4 shows, first of all, at the top in figure 2, that's where he is putting together
5 the collar, which he has numbered 38, actually, in figure 2, with the web of
6 material, and the red part is where the adhesive is applied.

7 See, the red part only applied to one side of that tear strip, 26. And so
8 you wind up with a carton blank as shown in figure 3 and the adhesive is
9 along in that red area to the right of the tear strip. You can't put any
10 adhesive to the left of the tear strip or, as I say, you wouldn't be able to open
11 the carton once you pulled off the tear strip.

12 Now, the examiner says this anticipates our claim where the claim
13 says you are applying -- you know, you are adhering it -- adhering the ribbon
14 to substantially all of the panel portion, and we just -- it's kind of hard for me
15 to see how in the world the examiner gets to that conclusion because, as you
16 can see, there are -- the blank in Stone has panel portion 16, 18, 20, 22.

17 And the ribbon, which he calls 46, I guess, in figure 3, is adhered
18 along across those panel portions, and then it is just adhered in the red area.
19 So it is clearly not adhered to substantially all, if any, of those panel
20 portions.

21 The only other thing the examiner has come up with, examiner says,
22 Well, that ribbon could be wider, so it goes all the way over.

23 (Cell phone interruption.)

24 MR. CALVERT: I'm sorry. I'm sorry. I think my phone is ringing. I
25 thought it was some kind of alarm. Sorry, Your Honors. I meant to turn it
26 off.

1 Anyway, the examiner says that this collar, I guess, could extend all
2 the way over until it gets to that fold line on the -- on the right-hand side.

3 But you can see, even if it did that, it still wouldn't be adhered to
4 substantially all of these panel portions because there would still be this part
5 over to the left of the tear strip, to the left of that red area, which would not
6 be adhered to the panel portions. So we just said -- the claims just are not
7 anticipated by the Stone patent.

8 Now, the examiner -- there is also, used as a secondary reference for
9 some of these claims, Stokes, but Stokes just shows that you can put plural
10 ribbons on the web, which doesn't really have much to do with this problem.
11 The problem he has with anticipation, it doesn't take care of that.

12 The examiner has another rejection, unpatentable over Lange in view
13 of Campbell. Now, Lange is concerned with making cartons from
14 corrugated material. And what Lange wants to do, he wants to -- he is
15 concerned with the problem of printing on corrugated material.

16 There is, as he says in column 5 through column 6, he says that
17 because of the ridged and irregular corrugated surface to which the print
18 must be applied, the quality of the print is degraded and printing on graphics
19 applied during the conversion process are inferior in quality.

20 So what he wants to do is apply -- laminate a high-quality layer onto
21 this corrugated material. And this high-quality layer, you know, can have
22 nice printing on it and makes the carton look real nice and so forth.

23 The examiner then takes Campbell -- Campbell is just -- he is making
24 cartons and he is putting reinforcing tapes along the fold lines, and the
25 examiner says, Well, Campbell shows that you can make a carton out of
26 corrugated or non-corrugated, and therefore, it is obvious to apply the Lange

1 process to non-corrugated material.

2 And of course, the claims all call for non-corrugated paperboard.

3 Well, I mean, that might be -- you know, it might be obvious in some
4 situations to say that, but here Lange is addressing a problem which you
5 don't have with paperboard, so why would you apply the Lange process to
6 paperboard?

7 Because paperboard, you can have nice-quality graphics just printing
8 directly on the paperboard. You don't have to apply this high-quality layer
9 or anything else. That's one of the advantages of paperboard. So we just
10 think that it is just unobvious to combine these two references.

11 Of course, we can't deny that, you know, you make cartons out of
12 corrugated or non-corrugated. That's no -- Campbell doesn't really add
13 much to that. But why would you apply the Lange process to non-
14 corrugated board? Because Lange is just addressing a problem which only
15 comes up with corrugated board, not with non-corrugated.

16 Now, I would like to point out something to you that the examiner
17 hasn't said anything about, but I think in the interest of full disclosure, I
18 should tell you that in Lange, which is pretty long patent, Lange, in column
19 9, talks about how this paper that he is going to apply is kind of weak and so
20 forth.

21 But then somewhat incongruously, in column 10, he turns around and
22 says this additional adhesive and finish layer add considerable strength to the
23 finished product, but still it doesn't seem like that is a teaching that you
24 would use it on non-corrugated board, because he further says you can use
25 lighter stock in order to offset increases in weight and expense which would
26 otherwise occur from the additional raw materials.

1 So it is like he applies the paper and then that makes it stronger, so
2 then he can cut back on his base material, you know, so he can -- he will
3 bring it back to the strength he had before he applied the paper.

4 Now, you might say, Well -- now, the examiner hasn't said any of this.
5 We are conjuring up this rejection ourself. You might say, Well, okay, you
6 are going to cut back on the -- on the stock. Why wouldn't you go ahead and
7 use paperboard?

8 Well, you wouldn't use paperboard because when you use paperboard,
9 you don't need this high-quality finish layer, so you would be kind of
10 chasing your tail around and around.

11 You know, you apply the paper to paperboard, but you don't need the
12 paper on the paperboard so you go back to corrugated, and I think the most, I
13 think, one of ordinary skill would get out of this disclosure here is, okay, you
14 can use lighter-weight corrugated material, but I don't think that it would be
15 a teaching that you could use it on paperboard.

16 JUDGE HORNER: Are there instances where you would want to
17 reinforce paperboard?

18 MR. CALVERT: I'm sorry?

19 JUDGE HORNER: I'm sorry. Are there instances where you would
20 want to reinforce corrugated?

21 MR. CALVERT: Well, no. He is not -- actually, he is not -- Lange is
22 not interested in reinforcing, the way I read it. He is just interested in
23 putting a nice-looking finish layer on there, and he just sort of says,
24 incidentally, Well, yeah, this does reinforce it.

25 So that's sort of a side benefit that you can use lighter-weight
26 corrugated board, see, but he is not really interested in that, and that's why

1 we don't think it would be obvious to apply it to paperboard.

2 I believe that's all we have -- the comments I have. If you all have
3 any questions, I would be glad to try to answer them.

4 JUDGE BAHR: Just one. Is there anyplace in the specification you
5 might point us to guide us in interpreting the language "substantially all"?

6 MR. CALVERT: "Substantially all"? Well, yes, there is some
7 disclosure concerning how close we put the reinforcing ribbons to the fold
8 lines. We don't want them actually over the fold lines, for the most part. If I
9 could see here, there is some -- actually, there is a -- let's see if I can find --
10 okay. It says "a predetermined short distance," on page 25.

11 The inboard edge of the ribbon is spaced a predetermined short
12 distance from the fold line so that when you fold the sheet along the fold
13 line, as illustrated in figure 5, the space between the edge of the ribbon and
14 the fold line ensures that the edge of the ribbon does not impact any of the
15 panels of the blank or otherwise interfere with the folding process.

16 So that's kind of where it is limited. And actually, at the top of page
17 26, he discloses that, Found at a distance between a fold line and the edge of
18 a reinforcing ribbon of about .030 inches allows unimpeded folding. So you
19 have -- basically, he wants about .030 inches between the edge of the
20 reinforcing ribbon and the fold line or the edge of the panel.

21 JUDGE BAHR: Okay. Thanks.

22 JUDGE CRAWFORD: Thank you.

23 MR. CALVERT: Thank you very much.

24 Whereupon, the proceedings at 1:19 p.m. were concluded.